UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,651	06/27/2003	Mark R. Albrecht	29321/2002C	7032

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EXAMINER
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ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/608,651	ALBRECHT, MARK R.
	Examiner	**Art Unit**	
	Vanel Frenel	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 June 2003</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected..

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the application filed on 6/27/03. Claims 1-

20 are pending.

Claim Rejections - 35 USC § 112

2.   Claim 1 recites the limitation "the ultimate" in line 7. There is insufficient

antecedent basis for this limitation in the claim. Appropriate correction is needed.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Baker (6,473,741) in view Dang et al (2003/0101111).

(A)   As per claim 1, Baker discloses the method comprising: for plural respective

direct service providers, loading, onto a remotely accessible part of a common host

server located in a given country, client specific financial files and corresponding

reference materials, the host server providing access to a remote computer client of

information concerning the ultimate client specific financial files and corresponding

reference materials (See Baker, Col.10, lines 56-67 to Col.11, line 20);

retaining outsourced personnel to perform tax return preparation services for clients of

the direct service providers during a tax season in a given year and to perform other

financial service projects for the clients of the direct service providers during a different

season of the given year, the outsourced personnel preparing the tax returns and

performing the other financial service projects while in an outsource country different

from the given country (See Baker, Col.3, lines 1-46); and monitoring and reporting the

status of the tax return preparation and of the other financial service projects (See

Baker, Col.12, lines 41-67).

Baker does not explicitly disclose a financial services outsourcing method for

facilitating a direct service provider's management of human resources for providing

financial services to numerous clients, the financial services being outsourced to an

outsourcing group abroad, providing the outsourced personnel limited access to the

server; the outsourced personnel performing the financial service project through a

remote limited access client located in the outsource country.

However, these features are known in the art, as evidenced by Dang. In

particular, Dang suggests a financial services outsourcing method for facilitating a direct

service provider's management of human resources for providing financial services to

numerous clients, the financial services being outsourced to an outsourcing group

abroad (See Dang, Page 12, Paragraph 0108), providing the outsourced personnel

limited access to the server (See Dang, Fig.6; Page 2, Paragraph 0011); the

outsourced personnel performing the financial service project through a remote limited

access client located in the outsource country (See Dang, Page 3, Paragraph 0015).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Dang within the system of Baker with the

motivation of enabling merchants to electronically outsource the burden of tax

calculation and remittance to state-certified service providers (See Dang, Page 6,

Paragraph 0035).

(B)   As per claim 2, Baker discloses the method wherein the tax return preparation

services comprise individual tax return preparation services (See Baker, Col.10, lines

56-67 to Col.11, line 2).

(C)   As per claim 3, Dang discloses the method wherein the tax returns and the other

financial services are outsourced through an intermediary firm to the outsourced

personnel (See Dang, Page 6, Paragraph 0035).

The motivation for combining the respective teachings of Baker and Dang are as

discussed above in claim 1, and incorporated herein.

(D)   As per claim 4, Baker discloses the method wherein the other financial service

projects comprise bookkeeping projects (See Baker, Col.3, lines 1-8).

(E)   As per claim 5, Dang discloses the method further comprising the intermediary

service firm interacting with the outsourced personnel through use of a servicing

computer system, and interacting with the plural direct service providers through use of

the servicing computer system (See Dang, Page 10, Paragraph 0086; Page 11,

Paragraph 0092).

The motivation for combining the respective teachings of Baker and Dang are as

discussed above in claim 1, and incorporated herein.

(F)   As per claim 6, Baker discloses the method wherein the direct service providers

comprise accounting firms (See Baker, Col.3, lines 1-8).

(G)   As per claim 7, Baker discloses the method wherein the host server provides

limited screen shot access to the remote client computer of information concerning the

client specific financial files and corresponding reference materials (See Baker, Fig.1;

Col.11, lines 3-35).

(H)   As per claim 8, Dang discloses the method wherein the host server comprises a

CITRIX server (The Examiner interprets Unix-based system and one Windows NT

server to be a form of CITIX server See Dang Page 12, Paragraph 0104).

(I)   As per claim 9, Baker discloses the method wherein the host server provides

limited screen shot access to the remote client computer of information concerning the

ultimate client specific financial files and corresponding reference materials (See Baker,

Fig.1, Col.11, lines 3-35).

(J)   As per claim 10, Dang discloses the method wherein the host server comprises a

CITRIX server (The Examiner interprets Unix-based system and one Windows NT

server to be a form of CITIX server See Dang Page 12, Paragraph 0104).

(K)   As per claim 11, Baker discloses the method wherein the host server comprises

an ASP server running tax software for use by plural independent direct service

providers provided with access to the ASP server (The Examiner interprets tax

preparation firms 10 in electronic format as simply a backup of the database of their

respective tax preparation software to be a form of plural independent direct service

providers provided with access to the ASP server See Baker, Col.10, lines 56-67).

(L)   As per claim 12, Baker discloses the method wherein the host server comprises

an ASP server running tax software for use by plural independent direct service

providers provided with access to the ASP server (The Examiner interprets tax

preparation firms 10 in electronic format as simply a backup of the database of their

respective tax preparation software to be a form of plural independent direct service

providers provided with access to the ASP server See Baker, Col.10, lines 56-67).

(M)   As per claim 13, Baker discloses the method wherein the corresponding

reference materials comprise image files of physical reference materials (See Baker,

Col.2, lines 1-11).

(N)   As per claim 14, Baker discloses the method wherein the client specific financial

files and corresponding reference materials comprise tax filer specific tax files and

image files (See Baker, Col.9, lines 53-64).

(O)   As per claim 15, Baker discloses the method further comprising loading onto the

remotely accessible part of the host server tax preparation software (See Baker, Col.9,

lines 60-64).

(P)   As per claim 16, Baker discloses the method wherein the outsourced personnel

prepare tax returns while located in India (The Examiner interprets private industry to be

a form of outsourced personnel prepare tax returns while located in India (See Baker,

Col.42-67 specifically lines 59-67).

(Q)   As per claim 17, Baker discloses the method further comprising a given direct

service provider interviewing a tax filer and obtaining supporting documentation for the

tax flier's tax return (See baker, Col.11, lines 27-35).

(R)   As per claim 18, Baker discloses the method wherein the direct service provider

comprises an accounting firm (See Baker, Col.3, lines 37-47).

(S)   As per claim 19, Baker discloses the method wherein the supporting

documentation comprises the last season tax return as filed, receipts, and summary

information regarding finances of the tax filer (See Baker, Col.12, lines 1-29).

(T)   As per claim 20, Baker discloses the method further comprising the given direct

service provider setting up a tax file compatible with a given tax software package (See

Baker, Col.9, lines 53-64), and rendering the supporting documentation electronic (See

Baker, Col.11, lines 27-35).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The cited but not the applied prior art teaches fully-automated

system for tax reporting, payment and refund and system for accessing tax information

(2001/0037268, method for business solutions (2003/0097319) and Outsourcing return

processing could reduce costs, IRS says Anonymous. Tax Management Financial

Planning Journal. Washington: Feb.18, 1997. Vol.13, Iss.2; pg, 49, 2pgs.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769.

The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vanel Frenel

Art Unit 3627

June 6, 2007